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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
David KAMINSKY, et al.	:	Confirmation Number: 1386
	:	
Application No.: 10/635,598	:	Group Art Unit: 2151
	:	
Filed: August 6, 2003	:	Examiner: K. Tang
	:	
For: INTELLIGENT MAIL GATEWAY	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed August 27, 2007, wherein Appellants appeal from the Examiner's rejection of claims 1-24.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on August 6, 2003, at Reel 014400, Frame 0865.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-24 are pending and finally rejected in this Application. It is from the final rejection of claims 1-24 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second Office Action dated May 25, 2007 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 1 and independent claim 1, an intelligent electronic mail (e-mail) gateway 140 is disclosed. The gateway 140 includes a message store 180 and a notification manager 200. The message store 180 is configured to store received messages 190 forwarded by senders 110 over a network 130 to a mail server 150 coupled to the e-mail gateway 140 and associated with corresponding intended recipients 160 (lines 9-12, paragraph [0018] of Appellants' disclosure). The notification manager 200 is coupled both to the gateway 140 and the message store 180 (lines 1-5, paragraph [0020]). The manager 200 is configured to notify selected ones of the senders 110 when delivery to the intended recipients 160 has become impaired (lines 1-10 of paragraph [0020]).

Referring to Figure 2 and independent claims 5 and 15, a method for intelligently handling an impairment to the delivery of e-mail messages to intended recipients in a mail delivery system is disclosed. In blocks 210, 220, received e-mail messages are stored prior to forwarding the messages to inboxes of respective mail servers (lines 1-5 of paragraph [0021]). In block 230, an impairment to delivering the messages to the inboxes is detected (lines 5-11 of

paragraph [0021]). In block 240, senders for selected ones of the messages are identified (lines 15-16 of paragraph [0022]). In block 250, a notification of the impairment is forwarded to the identified senders (line 17 of paragraph [0022]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-24 were rejected under the second paragraph of 35 U.S.C. § 112;
2. Claims 1, 4-6, and 15-16 were rejected under 35 U.S.C. § 102 for anticipation based upon Spear, U.S. Patent Publication No. 2003/0149726;
3. Claims 7-8 and 17-18 were rejected under 35 U.S.C. § 103 for obviousness based upon Spear in view of Shuster, U.S. Patent Publication No. 2002/0023135;
4. Claims 9 and 19 were rejected under 35 U.S.C. § 103 for obviousness based upon Spear in view of Eguchi, U.S. Patent Publication No. 2001/0040694;
5. Claims 3, 10-11, and 20-21 were rejected under 35 U.S.C. § 103 for obviousness based upon Speak in view of Pearson et al., U.S. Patent Publication No. 2005/0235360 (hereinafter Pearson);
6. Claims 12-14 and 22-24 were rejected under 35 U.S.C. § 103 for obviousness based upon Spear in view of Generous et al., U.S. Patent Publication No. 2002/0120697 (hereinafter Generous); and
7. Claim 2 was rejected under 35 U.S.C. § 103 for obviousness based upon Spear in view of Katagiri et al., U.S. Patent Publication No. 2002/0073364 (hereinafter Katagiri) in view of Generous.

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-16 UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

For convenience of the Honorable Board in addressing the rejections, and claims 2-4 stand or fall together with independent claim 1, and claims 6-16 stand or fall together with independent claim 5.

Appellants respectfully submit that the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. As stated in M.P.E.P. § 2173.02:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." The Examiner, however, has not met this burden.

The Examiner identified "said manager" in claim 1, line 6 and asserted that "[t]here is insufficient basis for this limitation in the claim." This assertion, however, is incorrect. Claim 1, line 5 clearly recites "a notification manager." Thus, antecedent basis exists for "said manager" in line 6 of claim 1. Similarly, although the Examiner identified "said messages" in claim 5, line 6 and asserted that "[t]here is insufficient basis for this limitation in the claim," this assertion is

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

also incorrect. Claim 5, lines 1-2 clearly recites "delivery of e-mail messages." Thus, antecedent basis exists for "said messages" in line 6 of claim 5.

Appellants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claims 1 and 5, particularly when reasonably interpreted in light of the written description of the specification.² Therefore, for the reasons stated above, Appellants respectfully submit that the Examiner has not set forth a proper rejection under the second paragraph of 35 U.S.C. § 112.

**THE REJECTION OF CLAIMS 1, 4-6, AND 15-16 UNDER 35 U.S.C. § 102 FOR
ANTICIPATION BASED UPON SPEAR**

For convenience of the Honorable Board in addressing the rejections, and claims 4-6 and 15-16 stand or fall together with independent claim 1.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.³ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁴ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the

² In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

³ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁴ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.⁵ This burden has not been met.

Independent claim 1 recites, in part, the following limitations:

a notification manager coupled both to the gateway and said message store, said manager having a configuration for notifying selected ones of said senders when delivery to said intended recipients has become impaired.

Similarly, independent claims 5 and 15 recite, in part, the following limitations:

forwarding a notification of said impairment to said identified senders.

To teach these limitations, the Examiner relied upon lines 11-12 of paragraph [0030] within Spear. For ease of reference, lines 9-12 of paragraph [0030] is reproduced below:

Emails that do not satisfy the prescribed criteria in order to be normally processed may be discarded, stored, or sent back to the original sender (recognizing that the address the sender provided probably is fictitious).

As apparent from this teaching, Spear does not teach forwarding a notification of impairment to deliver a message to a sender of the message. Instead, Spear teaches that the message is merely sent back to the original sender. Absent from Spear is an explicit teaching that the sending an e-mail back to the original sender constitutes a notice that delivery to the intended recipient has become impaired.

Moreover, the Examiner cannot rely upon the doctrine of inherency to disclose this feature. The mere fact that a certain thing may result from a given set of circumstances is not

⁵ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

sufficient to establish inherency.⁶ To establish inherency, the extrinsic evidence must make clear that the missing function must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁷ This burden has not been met. For example, receipt, by the sender, of an e-mail does not necessarily constitute a notification that delivery to the intended recipient has become impaired since delivery could have still been performed.

Appellants presented the above arguments on pages 5 and 6 of the First Amendment dated May 2, 2007 (hereinafter the First Amendment). In response to these argument, the Examiner asserted the following on pages 5 and 6 of the Second Office Action:

Applicant has to understand that according to the broadly claimed limitation "notifying one of said senders,, etc.", applicant did not claimed the type of notification is being sent to the sender, nor did applicant claiming how to notify the sender when the delivery to said intended recipients has become impaired. Therefore, from Spear, sending back the email to the sender constitutes the action of "notifying", and the email is only being sent back when it is determined the delivery to the recipients has become impaired (email fails to satisfied the characteristics/filter rules, e.g., recipient address was not correct, refer to Spear, 0028. applicant never argued what is meant by "impaired", therefore, it is being interprets as recipients). Therefore, Spear reads on applicant's limitations.

Appellants respectfully disagree with the Examiner's analysis.

The Examiner's analysis is lacking since the Examiner has failed to set forth a claim construction for the phrases "notifying selected ones of said senders when delivery to said intended recipients has become impaired," as recited in claim 1, and "a notification of said impairment," as recited in claims 5 and 15. Both of these passages are directed to the concept of

⁶ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁷ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

sending a notification (i.e., a message giving notice of a piece of information). Moreover, the "piece of information" being conveyed is that an impairment has occurred in sending messages to intended/identified recipients.

The Examiner's assertion that "sending back the email to the sender constitutes the action of 'notifying'" is erroneous since the teachings of Spear are silent as to the particular message that is being conveyed (i.e., giving notice of a piece of information) when the e-mail is sent back to the sender. Since the teachings of Spear are silent as to the particular message that is being conveyed, Spear cannot teach that the message being conveyed is that an impairment has occurred in sending messages to intended/identified recipients.

The Examiner asserted that "the email is only being sent back when it is determined the delivery to the recipients has become impaired." This teaching alone, however, is not dispositive as to whether a notification was provided by the e-mail being sent back.

For information to be successfully conveyed from a first party to a second party, there must be some pre-agreement (or assumption) as to the form of the information and/or as to how the second party is to interpret the message. For example, if an e-mail from the first party to a second party was written in English, then the pre-agreement/assumption is that the second party understands written English for the information contained in the e-mail to be successfully transmitted. Moreover, if the e-mail, for example, solely contained the numbers "\$30,000 from 12345679, 12345ABCDEF to 234567891, 45678HIJKLMN" and if both parties knew that the first number represented a dollar amount and the second and third numbers and the third and

fourth numbers respectively represented routing and account numbers to transfer the dollar amount from and to, then the information can be successfully conveyed. However, if the second party is unaware of the aforementioned convention with regard to what the numbers mean, then the information would not be successfully conveyed despite the first party knowing what the numbers mean.

Returning to the Examiner's assertion that "the email is only being sent back when it is determined the delivery to the recipients has become impaired," this information can only be conveyed (i.e., noticed) when the second party (i.e., the receiving party) understands that when the e-mail is sent back, then "delivery to the recipients has become impaired." The Examiner, however, has not established that Spears teaches that the recipient of the returned e-mail understands that "delivery to the recipients has become impaired." Therefore, despite the first party knowing that sending the e-mail back occurs when delivery to the recipients has allegedly become impaired, the information is not conveyed if the second party does not understand what information is being conveyed upon the e-mail being sent back to the second party.

Thus, the Examiner has failed to establish that Spears explicitly teaches the above-identified limitations. Moreover, as already argued in the First Amendment, the Examiner has failed to set forth a proper inherency argument so as to establish that the recipient of the returned e-mail (i.e., the original sender of the e-mail) would necessarily associate the returned e-mail with a "notice" that "delivery to the recipients has become impaired." Therefore, for the reasons stated above, Appellants respectfully submit that the Examiner has failed to establish that Spears

identically discloses the claimed invention, as recited in claims 1, 4-6, and 15-16, within the meaning of 35 U.S.C. § 102.

**THE REJECTION OF CLAIMS 7-8 AND 17-18 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON SPEAR IN VIEW OF SHUSTER**

For convenience of the Honorable Board in addressing the rejections, and claim 17 stands or falls together with dependent claim 7, and claim 18 stands or falls together with dependent claim 8.

Claims 7, 17 and 8, 18 respectively recite the claimed "detecting an impairment" includes concept of consulting/probing for information regarding the claimed "said respective servers." In the statement of the rejection, the Examiner referred to lines 17-22 of paragraph [0039] within Shuster to teach these limitations. For ease of reference, the Examiner's cited passage is reproduced below:

Then, the destination mail server would obtain the delivery code list belonging to the root address, determine whether the message address contained a valid delivery code, and if so, place the message in the addressee's inbox folder in a subdirectory (folder) belonging to the corresponding delivery code.

At the outset, Appellants note that the Examiner's cited passage is not relevant to the limitations at issue. Shuster does not teach "consulting a data store of state information for selected ones of said respective mail servers" (i.e., claims 7 and 17) or "probing selected ones of said respective mail servers to detect said impairment (i.e., claims 8 and 18). Instead, Shuster teaches checking whether a message address contains a valid delivery code, which is not related to the statement information and/or impairment of the claimed respective servers.

Appellants presented the above arguments on pages 6 and 7 of the First Amendment. In response to these arguments, the Examiner asserted the following on pages 6 and 7 of the Second Office Action:

In reply to argument (2): Again, due to the broadly claimed language, "a data store of state information for selected ones of said respective mail servers to call an already identified impairment", Shuster disclosed there is at least one of mail server in the system (refer to 0033, lines 7), and by having the delivery codes (state information in the data store), refer to Col 38, Lines 1-2, which helps in term of deliver to the appropriate destination. Shuster disclosed that each mailboxes 104a-d in Fig 1, is similar to network mail servers, each of which is provided with a unique network address through a registry system, Each server then may maintain a separate registry of unique account names. Each account name plus a mail server address comprises a fully qualified address for identifying a particular addressee. Each account name plus a mail server address comprises a fully qualified address for identifying a particular addressee according to a mail sender's delivery intention, refer to 0034, Lines 7-12. Thus, it is indicated that by having the delivery code along with the root address, it selected appropriate routes to the appropriate mail box (mail server), and then delivered to the destination. Thus, it is relevant to what is indicated in the claim limitation.

At the outset, Appellants note that the Examiner did not address the above-reproduced arguments by Appellants. Instead, the Examiner went off on a tangent within regard to the claimed "data store of state information" (which is only found in claims 7 and 17 and not claims 8 and 18).

Apparently, albeit not explicitly stated, the Examiner is inferring that the "delivery codes" disclosed by Shuster somehow correspond to the claimed "state information." The delivery codes disclosed by Shuster are addresses, which do not correspond to "state information for selected ones of said respective mail servers," as claimed. In this regard, Appellants note that the Examiner has failed to set forth a claim construction for the term "state information."

Accordingly, even if one having ordinary skill in the art were motivated to combine the applied prior art, the proposed combination of references would not yield the claimed invention. Appellants, therefore, respectfully submits that the imposed rejection of claims 7-8 and 17-18 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Shuster is not viable.

**THE REJECTION OF CLAIMS 9 AND 19 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON SPEAR IN VIEW OF EGUCHI**

For convenience of the Honorable Board in addressing the rejections, and claim 19 stands or falls together with claim 9.

It has been repeatedly held that one having ordinary skill in the art cannot be presumed realistically motivated to modify a reference in the manner inconsistent with the disclosed objectives.⁸ The Examiner's proposed modification, however, would achieve exactly that. In this regard reference is made to paragraph [0018] of Spear, which is reproduced below:

Accordingly, it has been desired for a mail server effectively to reject junk email, or spam, prior to receipt by an email account user, to do so in real time or with only a negligible delay, and to do so with a minimum of network resources. In addition, it is preferred that this could be achieved while not precluding the use of other types of email filters.

Thus, a clearly stated purpose of Spear is to prevent delivery of junk e-mail prior to recipient by an e-mail account user. The Examiner's proposed modification, however, would defeat this stated objective by "attempting to transmit said message," which is the alleged modification based upon Eguchi. Thus, one having ordinary skill in the art would not have been led to modify Spear in the manner suggested by the Examiner.

The Examiner ostensibly responded to Appellants' arguments as to the combination on Spear and Eguchi on page 7 of the Second Office Action. Upon reviewing the Examiner's characterization of Appellants' argument on pages 3 and 4 of the Second Office Action and the Examiner response on page 7 of the Second Office Action, it appears that the Examiner intended

⁸ In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); In re Schulpen, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).

to address the rejection based upon Spear in view of Pearson since the argument being addressed by the Examiner pertained to nonanalogous prior art, which was the argument presented by Appellants as to the combination of Spear and Pearson. Therefore, the Examiner failed to address the above-reproduced arguments by Appellants as to the Examiner's rejection of claims 9 and 19 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Eguchi.

**THE REJECTION OF CLAIMS 3, 10-11, AND 20-21 UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON SPEAR IN VIEW OF PEARSON**

For convenience of the Honorable Board in addressing the rejections, and claims 10-11 and 20-21 stand or fall together with claim 3.

Appellants respectfully submit that Spear is non-analogous prior art that cannot be applied against the claimed invention. Whether a prior art reference is from a nonanalogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference is reasonably pertinent to the particular problem with which the invention is involved.⁹ If the prior art is outside the inventor's field of endeavor, the inventor will only be presumed to have knowledge of prior art that is reasonably pertinent to the problem being addressed.¹⁰ The Examiner is also charged to consider "the reality of the circumstances' ... in other words, common sense" to determine what field a person of ordinary skill in the art would reasonably be expected to look.¹¹

⁹ In re Clay, 23 USPQ2d 1058 (Fed Cir. 1992).

¹⁰ In re Wood, 202 USPQ 171 (C.C.P.A. 1979).

¹¹ In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Whereas the claimed invention is directed to a mail server that detects electronic mail delivery failures in a mail delivery system, Spear is directed to the automation of reducing unsolicited email. Thus, the claimed invention and methodology of Spear are not within the same field of endeavor. Furthermore, the claimed invention is directed to, in part, solving the problem of how to notify a sender as to the failure of an e-mail server to deliver an e-mail to a targeted recipient. The teachings of Spear, however, are not reasonably pertinent to solving this problem. Thus, Spear is non-analogous prior art that cannot be applied against the claimed invention.

Appellants presented the above arguments on pages 8 and 9 of the First Amendment. In response to these arguments, the Examiner asserted the following on page 7 of the Second Office Action:

In reply to argument (3): Both Spear and Eguchi focus their system on improving emailing system. What Eguchi's system has functionality that can improve Spear's system, for example, it has capability of providing confirmation when the email has been successfully received, refer to 0017, lines 4-11, or the missing electronic mails, refer to 0035, Lines 7, by having these capabilities, the system is able to detect the fault within the emails transmission. (emphasis added)

Appellants note that the Examiner has identified the "field of endeavor" in an impermissibly broad manner. By characterizing the field of the endeavor as "on improving emailing system," the Examiner pulls in fields that are very different and may have limited applicability to one another. Appellants can conceive of many different fields that could be related to improving emails systems such as: filtering spam, database management of saved e-mails, the underlying computer device (i.e., improving the speed and/or functionality thereof), the formatting of the e-mail to be sent by a sender, how e-mail is efficiently transferred from a sender through a recipient via a network, how errors are treated by an e-mail server, how e-mails can be presented to a recipient in a GUI to name a few. All these fields are related to improving an e-mail system but are directed to very different concepts such as database management, networking, graphical user interfaces, and the underlying

hardware of the equipment upon which the e-mailing system operates. Thus, the Examiner's asserted "field of endeavor" is impermissibly overly broad.

Appellants also note that the above-argument as to Spear being non-analogous prior art applies to each of the Examiner's rejection 35 U.S.C. § 103 that employ, as a cited reference, Spear.

THE REJECTION OF CLAIMS 12-14 AND 22-24 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SPEAR IN VIEW OF GENEROUS

For convenience of the Honorable Board in addressing the rejections, and claims 13-14 and 22-24 stand or fall together with claim 22.

Appellants respectfully submit that the Examiner's proposed rationale to modify Spear in view of Generous would not have led one having ordinary skill in the art to combine the applied prior art so as to arrive at the claimed invention. The Examiner has failed to set forth a reasonable explanation as to why one having ordinary skill in the art would want to format a detailed notification to a sender of an e-mail when Spear teaches that the "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail.

Moreover, Appellants are entirely unclear as to what purpose would be served to prepare a notification that includes "both a statement of said impairment and an estimate of when normal mail delivery service can resume" or "both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages." In the first instance, the normal mail delivery serve will not resume because the e-mail is considered junk e-

mail. In the second instance, the alternative e-mail address would provide no purpose since this alternative e-mail address would now receive the junk e-mail.

Appellants presented the above arguments on page 10 of the First Amendment. In response to these arguments, the Examiner asserted the following on page 7 of the Second Office Action:

In reply to argument (4): Spear not only teaches "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail, but also errors on sender's IP address, MAC address, sender's address, recipient address, number of recipients, number of invalid recipients, etc. Any of these errors will trigger the mailing system to either discarded, stored, or sent back the email back to the original sender (refer to 0023-0030). Therefore, by combining with Generous, it provides the need to formatting the notification that comprises statement of the impairment and an alternative email address for use in retransmission. By modified the Spear's invention, it can improve the system by providing faster time and knowledge of the status of email, in order to retransmit the important message to the proper destination. (emphasis added)

Appellants note that the Examiner has intentionally misrepresented the teachings of Spear in the above-underlined passage. In this regard, reference is made to paragraph [0028] of Spear, which is reproduced below:

The email delivered to the delay queue 18 may be stored temporarily in a well-ordered structure by Internet protocol address, sender, subject or some other classification. In accordance with a first embodiment of the present invention, the email is held in the delay queue 18 and examined for certain characteristics. These characteristics may include the sender's Internet protocol (IP) address, MAC address, sender's address, recipient address, number of recipients, number of invalid recipients, if and how the message was encrypted during transport, if and how the sending user was authenticated, the subject, the message-ID, and the body of the message (ie, message content). The characteristics chosen may correspond to characteristics that are typically associated with unwanted email. For example, a single sender's address sent to numerous employees of an enterprise may reveal that the email is an unwanted advertisement. (emphasis added)

As readily apparent from this paragraph, the "sender's IP address, MAC address, sender's address, recipient address, number of recipients, number of invalid recipients," as identified by the Examiner, all relate to characteristics "that are typically associated with unwanted email." Thus, these characteristics identified by the Examiner are not in addition to Spear considering "the e-mail to be unwanted or junk e-mail." Instead, these characteristics are associated with the

e-mail to be unwanted or junk e-mail. Thus, the Examiner's analysis is predicated upon an improper characterization of the teachings of Spear.

Therefore, Appellants maintain that the Examiner has failed to set forth a reasonable explanation as to why one having ordinary skill in the art would want to format a detailed notification to a sender of an e-mail when Spear teaches that the "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail. Appellants also maintain that the Examiner has failed to clearly establish what purpose would be served by preparing a notification that includes "both a statement of said impairment and an estimate of when normal mail delivery service can resume" or "both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages" when the e-mail is considered to be junk e-mail.

**THE REJECTION OF CLAIM 2 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
SPEAR IN VIEW OF KATAGIRI AND GENEROUS**

For convenience of the Honorable Board in addressing the rejections, and claim 2 stands or falls together with claim 12.

Appellants incorporate herein the arguments previously presented within regard to the rejection of claims 12-14 and 22-24. The Examiner has not put forth a rationale explanation as to why one having ordinary skill in the art would create a notification that includes "an estimated time when said delivery will no longer be impaired; and an alternate e-mail address with which

said selected ones of said senders can retransmit said messages to corresponding intended recipients" when the e-mail that is sent is considered to be junk e-mail.

Appellants presented the above arguments on page 11 of the First Amendment. In response to these arguments, the Examiner asserted the identical argument that the Examiner presented in response to Appellants' prior arguments as to claims 12-14 and 22-24. Appellants, therefore, continue to maintain the above-reproduced arguments.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. §§ 102-103 and 112 are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102-103 and 112.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 30, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. An intelligent electronic mail (e-mail) gateway comprising:

a message store configured to store received messages forwarded by senders over a network to a mail server coupled to the e-mail gateway and associated with corresponding intended recipients; and,

a notification manager coupled both to the gateway and said message store, said manager having a configuration for notifying selected ones of said senders when delivery to said intended recipients has become impaired.

2. The gateway of claim 1, further comprising message generation logic programmed to format notifications for said senders which indicates at least one of an estimated down time of said mail server;

an estimated time when said delivery will no longer be impaired; and

an alternate e-mail address with which said selected ones of said senders can retransmit said messages to corresponding intended recipients.

3. The gateway of claim 1, wherein said selected ones of said senders comprises at least one of senders who have been determined to be priority senders and senders who have labeled their respective messages urgent.

4. The gateway of claim 1, wherein said message store is a queue.

5. A method for intelligently handling an impairment to the delivery of e-mail messages to intended recipients in a mail delivery system, the method comprising the steps of:

storing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers;

detecting an impairment to delivering said messages to said inboxes;

identifying senders for selected ones of said messages; and,

forwarding a notification of said impairment to said identified senders.

6. The method of claim 5, wherein said storing step comprises the step of queuing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers.

7. The method of claim 5, wherein said detecting step comprises the step of consulting a data store of state information for selected ones of said respective mail servers to recall an already identified impairment.

8. The method of claim 5, wherein said detecting step comprises the step of probing selected ones of said respective mail servers to detect said impairment.

9. The method of claim 5, wherein said detecting step comprises the steps of:

attempting to transmit said messages; and,

concluding the existence of an impaired state when said attempt fails.

10. The method of claim 5, wherein said step of identifying comprises the step of identifying only priority senders.

11. The method of claim 5, wherein said step of identifying comprises the step of identifying only senders of urgent messages.

12. The method of claim 5, wherein said forwarding step comprises the steps of:
formatting a detailed notification describing a nature of said impairment; and,
forwarding said detailed notification to said identified senders.

13. The method of claim 5, wherein said forwarding step comprises the steps of:
formatting a notification comprising both a statement of said impairment and an estimate of when normal mail delivery service can resume; and,
forwarding said detailed notification to said identified senders.

14. The method of claim 5, wherein said forwarding step comprises the steps of:
for each of said identified senders, formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and,
forwarding said detailed notification to said identified senders.

15. A machine readable storage having stored thereon a computer program for intelligently handing an impairment to the delivery of e-mail messages to intended recipients in a

mail delivery system, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

storing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers;

detecting an impairment to delivering said messages to said inboxes;

identifying senders for selected ones of said messages; and,

forwarding a notification of said impairment to said identified senders.

16. The machine readable storage of claim 15, wherein said storing step comprises the step of queuing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers.

17. The machine readable storage of claim 15, wherein said detecting step comprises the step of consulting a data store of state information for selected ones of said respective mail servers to recall an already identified impairment.

18. The machine readable storage of claim 15, wherein said detecting step comprises the step of probing selected ones of said respective mail servers to detect said impairment.

19. The machine readable storage of claim 15, wherein said detecting step comprises the steps of:

attempting to transmit said messages; and,

concluding the existence of an impaired state when said attempt fails.

20. The machine readable storage of claim 15, wherein said step of identifying comprises the step of identifying only priority senders.

21. The machine readable storage of claim 15, wherein said step of identifying comprises the step of identifying only senders of urgent messages.

22. The machine readable storage of claim 15, wherein said forwarding step comprises the steps of:

formatting a detailed notification describing a nature of said impairment; and,
forwarding said detailed notification to said identified senders.

23. The machine readable storage of claim 15, wherein said forwarding step comprises the steps of:

formatting a notification comprising both a statement of said impairment and an estimate of when normal mail delivery service can resume; and,
forwarding said detailed notification to said identified senders.

24. The machine readable storage of claim 15, wherein said forwarding step comprises the steps of:

for each of said identified senders, formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and,

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forwarding said detailed notification to said identified senders.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.